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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,542	04/30/2001	Roger Bredow	RSW920010064US1	3395

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EXAMINER


FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/845,542	Applicant(s) BREDOW ET AL.	
	Examiner Mark Fadok	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Remarks

The examiner is in receipt of applicant's response to office action mailed 5/5/2004, which was received 8/10/2004. Acknowledgement is made that there were no amendments to the claims, leaving claims 1-21 as pending in the instant application. The applicant's remarks have been carefully considered, but were not found to be persuasive; therefore the previous rejection is restated below:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

In response to claim 1, Sherr discloses a method of presenting a shopping summary associated with electronic commerce, comprising the acts of:

detecting a right click of a computer mouse on a web page (page 7, para 071);
and

Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a shopping summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer.

In response to claim 2, Sherr teaches wherein the act of showing further comprises the act of accessing a second web page that includes the shopping summary (see response to claim 1, order page).

In response to claim 3, Sherr teaches wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping summary (see response above and FIG 2, item 206).

In response to claim 4, Sherr discloses a method of presenting a shopping cart for on-line shopping, comprising the acts of:

detecting a right click of a computer mouse on an on-line shopping web page (see response to claim 1); and

showing a shopping cart responsive to detecting the right click of the computer mouse on the on-line shopping web page (see response to claim 1, and FIG 14).

In response to claim 5, Sherr teaches wherein the act of showing further comprises the act of accessing a second web page that includes the shopping cart (see response to claim one and FIG 14).

In response to claim 6, Sherr teaches wherein the act of showing further comprises the act of opening a web page overlay that includes the shopping cart. (see response to claim 1,3, and 5)

In response to claim 7, Sherr discloses a method of displaying a bidding summary for an on-line auction, comprising the acts of:

detecting a right click of a computer mouse on an on-line auction web page (see response to claim 1); and

Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a bidding summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue due to satisfying the needs of the customer.

In response to claim 8, Sherr teaches wherein the act of showing further comprises the act of accessing a second web page that includes the bidding summary (see response to claim 7, order page).

In response to claim 9, Sherr teaches wherein the act of showing further comprises the act of opening an overlay that includes the bidding summary (see response to claim 7 and FIG 2, item 206).

In response to claim 10, Sherr discloses a method of presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page (page 7, para 071);

deriving a screen location from screen coordinates of the computer mouse (page 6, para 0067);

creating an overlay that includes a shopping summary (FIG 2, item 206); and
showing the overlay upon the web page at the derived location (FIG 2, item 206).

In regards to claims 11-15, Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing all the different summaries in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying summaries as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering

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this flexibility would increase the sale and use of the system and thus create increased revenue by satisfying the needs of the customer.

In response to claim 15, Sherr discloses using the right click of a mouse to perform a limited programmed function such as entering an order page within a current webpage (see response to claims 1-14), but does not specifically mention that the right click is used to open and close an application such as a shopping summary. Turning programs on and off utilizing a single on/off switch activation mechanism such as a mouse click is old and well known in the art. It would have been obvious to a person having ordinary skill in the art to change the right click programming to include on/off capability, because this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage.

In response to claim 16, Sherr teaches wherein the shopping summary is included in a second web page (see response to claim 1, order page).

In response to claim 17, Sherr teaches wherein the shopping summary is included in an overlay upon the electronic commerce web page (see response to claim 1, 3, and 5).

In response to claims 18-21, Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing all the different summaries in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying summaries as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue by satisfying the needs of the customer.

Response to Arguments

Applicant's arguments filed 8/10/2004 have been fully considered but they are not persuasive.

Applicant argues that the examiner has used improper circular reasoning. The examiner disagrees and notes that the applicant has piecemealed his analysis of the motivation presented by the examiner and has therefore erred in his argument. Even so, the examiner presents the article "Mission critical" to define the fine distinction between valid deductive reasoning and fallacious circular reasoning. When the entire motivation is considered as a whole, the reasoning becomes evident in that it is notoriously well known that adding additional functionality that is helpful to the user creates a satisfied user, and it is more likely that satisfied users would return and use a product. Furthermore, "as persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making

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findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons. Absent legal error or contrary factual evidence, those findings can establish a prima facie case of obviousness. In this case, the appellants have not pointed to any legal error affecting the Board's obviousness analysis. Nor have they pointed to sufficient factual grounds, either in the record or in any judicially noticeable sources, to question the findings made by the examiner and the Board as to the teachings of the prior art and the motivation that the prior art references would give to a skilled artisan to make the claimed invention." *In re Burg* CAFC, 02-1120, -1160, 2/20/2003.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has provided motivations that would have been evident to one of ordinary skill in the art.

Applicant requests that the examiner provide an evidentiary article to support his contention of official notice. In response, the examiner presents the helpcommunity

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article that teaches programmers how to program the right click button to add any functionality. It is noted that the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays ect.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step. Sherr teaches in paragraphs 71,85 and 95 that the use of the right click can open an order screen or a display. As is contemplated by Sherr, a plurality or programmed displays may be adapted to be presented by the right click button of mouse without changing the manipulative step of pressing the right click button.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the steps of creating and showing are positioned by the manipulative steps of detecting and deriving, i.e. the claims read in the broadest reasonable interpretation do not included this manipulation argued by the applicant.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claim 15, applicant argues that the examiner does not treat the feature, "when the right click is detected, determining whether a shopping summary is shown". As noted above the item detected (an open shopping cart) is considered by the

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examiner to be non-functional language, because no manipulative step is provided by the shopping cart and could just as well have been any other displayed item being turned off or on, therefore the turning on and off of the specific display of the shopping cart is irrelevant. Furthermore, the examiner disagrees that the step of determining was not addressed. The examiner contends that a reasonable person of ordinary skill in the art would conclude that in order for a program to be turned off by the click of a button, the active program would need to be recognized. In regards to applicant's request for a citing were a right mouse click is used to turn a display on and off, the examiner provides Langlois et al (6,018,571) and directs the applicant's attention to col 8, line 60 – col 9, line 4).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

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A handwritten signature in black ink, appearing to read 'Mark Fadok', followed by a long horizontal line extending to the right.

Mark Fadok

Patent Examiner